

Remarks

The various parts of the Office Action are discussed below under similar headings.

Election/Restrictions

In view of the requirement for restriction imposed by the Examiner, claims 9-11 have been cancelled.

Specification

The withdrawal of the objection to the disclosure is noted with appreciation.

Claim Objections

The withdrawal of the objection to claim 6 is noted with appreciation.

Claim Rejections - 35 USC § 112

The withdrawal of the rejection of claims 1-7 under 35 U.S.C. 112 is noted with appreciation.

Claim Rejections - 35 USC § 103

Before discussing the prior art rejections, it is noted that several editorial changes have been made in the claims. In addition, claims 5 and 6 have been consolidated into amended claim 5 which has been rewritten in independent form, and claim 6 has been cancelled.

In addition, claim 1 has been amended to recite the addition of a flow-promoting agent to the dispersion containing amino resin and an abrasive substance.

U.S. Patent No. 6,231,670 Is Not Prior Art

Claims 1-8 have been rejected over a combination of references including Fisher et al. U.S. Patent No. 6,231,670. The '670 does not qualify as prior art to the invention herein claimed and therefore the rejection is improper for at least this reason. The Examiner's attention is invited to MPEP Section 901.04 which reads as follows:

The following different series of U.S. patents are being or in the past have been issued. The date of patenting given on the face of each copy is the publication date and is the one usually cited. The filing date, in most instances also given on the face of the patent, is ordinarily the effective date as a reference (35 U.S.C. 102(e)). See MPEP § 2127, paragraph II. The 35 U.S.C. 102(e) date for a nonprovisional application claiming the benefit of a prior provisional application (35 U.S.C. 111(b)) is the filing date of the provisional application. (emphasis added)

and to MPEP Section 2136.03 which reads:

**Reference's Foreign Priority Date Under 35 U.S.C. 119(a)-(d) and (f)
Cannot Be Used as the 35 U.S.C. 102(e) Reference Date**

A U.S. patent reference is effective prior art as of its U.S. filing date. 35 U.S.C. 119(a)-(d) and (f) does not modify section 102(e) which is explicitly limited to certain references "filed in the United States before the invention thereof by the applicant" (emphasis added). Therefore, the foreign priority date of the reference under 35 U.S.C. 119(a)-(d) and (f) cannot be used to antedate the application filing date. In contrast, applicant may be able to overcome the 35 U.S.C. 102(e) rejection by proving he or she is entitled to his or her own 35 U.S.C. 119 priority date which is earlier than the reference's U.S. filing date. *In re Hilmer*, 359 F.2d 859, 149 USPQ 480 (CCPA 1966) (*Hilmer I*) (Applicant filed an application with a right of priority to a German application. The examiner rejected the claims over a U.S. patent to Habicht based on its Swiss priority date. The U.S. filing date of Habicht was later than the application's German priority date. The court held that the reference's Swiss priority date could not be relied on in a 35 U.S.C. 102(e) rejection. Because the U.S. filing date of Habicht was later than the earliest effective filing date (German priority date) of the application, the rejection was reversed.). See MPEP § 201.15 for information on procedures to be followed in considering applicant's right of priority. (emphasis added)

The effective date of the '670 patent as a reference is January 14, 2000. The present application has an effective filing date of January 26, 1999. Therefore, the rejection should be withdrawn for at least this reason and the finality of the last Office Action should be withdrawn as well.

In the Advisory Action dated October 22, 2002, the Examiner responded to the foregoing observations respecting the non-prior art status of the '670 patent. According to the Examiner, metering rollers are well known in the paper art and are conventionally used for removing an excess of a resin from a paper web to a predetermined final resin amount. In view of this the Examiner states that even without the '670 patent the use of

metering rolls in a paper coating process would have been obvious to one of ordinary skill in the art "since they are conventionally used in a paper coating process." Thus, what the Examiner appears to be saying is that she does not need to rely on the '670 patent to reject the claims. However, as presently stated the rejection does rely on the '670 patent and thus as presently stated the rejection is improper.

The Examiner also contends that the '670 patent can be used as a proper reference since it cites Swiss Patent 432,816 having a publication date of 1965. Applicant's undersigned representative respectfully disagrees. The citation of a prior art publication does not make the citing document prior art. If the Examiner is relying on the teachings of Swiss Patent 432,816, then the rejection should reference the same and not a document that does not qualify as prior art.

The foregoing may seem trivial. However, the undersigned must look to the rejection as stated by the Examiner and respond thereto. If, for example, the Examiner restates the rejection, substituting the Swiss patent for the '670 patent, then the newly stated rejection will be analyzed. Accordingly, the teachings of the Swiss patent would be carefully considered to see if the same supported a conclusion of obviousness. But, there could be teachings in the Swiss patent that teach away from the present invention. What if the Swiss patent taught against the use of metering rolls in the production of wear-resistant laminate flooring material for some reason.

In view of the foregoing, it is respectfully submitted that the rejection is improper for at least the reason that it is based on a non-prior art reference.

Amended Claim 1

Even if the '670 patent qualified as prior art, it is submitted that the claims would otherwise be patentable because any fair combination of the references would not yield the applicant's invention as set forth in the claims. In addition, the rejection of claim 1 is now moot in that claim 1 has been amended to recite the addition of a flow-promoting agent to the dispersion containing amino resin and an abrasive substance. As discovered by applicant, an improved distribution of the wear-resistant material can be obtained by the addition of a flow-promoting material. See page 3, first paragraph, of applicant's specification.

Prior to applicant's invention, conventional practice was to employ a dispersion containing viscosity-increasing materials. See page 1, second paragraph, and page 3, first paragraph, of applicant's specification. In view of this, it is surprising to introduce a

flow-promoting material. That is, the addition of a flow-promoting material is contrary to the then prevailing practice in the industry. Thus, for at least this reason claim 1 and the claims dependent therefrom are submitted as being patentable over the prior art of record.

Amended Claim 5

It is also respectfully submitted that the applied references do not teach or suggest the method of amended claim 5 wherein the abrasive substance comprises at least one of aluminium oxide and silicon carbide having a mean particle size of 60 to 160 $\mu\text{-m}$. The particle size of Hosler U.S. Patent No. 4,505,974¹ is comparatively small, noting in particular the preferred particle size range from about 20 to 60 millimicrons (see claim 6). Further, the particle size disclosed by Michl U.S. Patent No. 3,135,643 ranges to 1 micron (see Example 1). Thus, the skilled person would not be motivated to use as an abrasive material at least one of aluminium oxide and silicon carbide having a mean particle size of 60 to 160 $\mu\text{-m}$ in the performance of the methods taught by Hosler and Michl. Moreover, no such motivation can arise from Lindgren et al. U.S. Patent No. 5,034,272 as this patent relates to a significantly different process than those disclosed by Hosler and Michl, particularly since any increase in particle size relative to the teachings of Hosler and Michl would result in a deviation from the intended objectives of Hosler and Michl.

The Examiner has responded to the foregoing in the Advisory Action. In doing so, the Examiner contends that the "method of Hosler is irrelevant because Hosler is cited merely as evidence for spraying being functionally equivalent to knife coating of Michl." The undersigned respectfully disagrees. It is improper to pick and choose a feature from a reference while ignoring the context in which such feature is used. This is rejection by hindsight. Rather, a reference must be considered for all that it teaches as this is what is presented to the skilled person. That is, the feature upon which the Examiner relies must be read in the context of the entire disclosure and then a determination made as to whether the skilled person would have been motivated by the totality of the teachings of the reference to modify the base reference in a manner giving rise to the claimed subject matter. In the present case, Hosler would not have provided the requisite motivation for the reasons previously advanced. Likewise,

¹ The '974 patent does not appear to have been properly made of record in that it is not listed on a PTO-892 form. Also, a copy of the reference was not supplied with the Office Action.

Lindgren et al. does not provide the requisite motivation for the above discussed reasons.

Conclusion

Allowance of the application is respectfully requested.

Respectfully submitted,

RENNER, OTTO, BOISSELLE & SKLAR, LLP

By



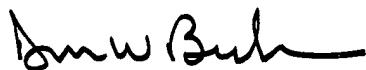
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Date: December 12, 2002



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